

The opinion in support of the decision being entered today was *not* written for publication and is *not* binding precedent of the Board.

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte BARRY BARTON, VICKI DOUGHERTY, and JON FORST

Appeal 2007-1713
Application 09/391,460
Technology Center 3600

Decided: June 21, 2007

Before HUBERT C. LORIN, LINDA E. HORNER, and ANTON W. FETTING,
Administrative Patent Judges.

HORNER, *Administrative Patent Judge.*

DECISION ON APPEAL

STATEMENT OF THE CASE

Appellants seek our review under 35 U.S.C. § 134 (2002) of the Examiner's final rejection of claims 1-15, all of the pending claims in the application. We have jurisdiction under 35 U.S.C. § 6(b) (2002).

SUMMARY OF DECISION

We REVERSE and REMAND to the Examiner for further consideration of the patentability of the pending claims.

THE INVENTION

Appellants' claimed invention is to a computer system for "generating advice related to financial payment strategies that are tailored to a particular individual's changing economic circumstances" and, specifically, for "generat[ing] negotiation advice based on the way an individual interacts with a system user when discussing the individual's economic circumstances" (Specification 2). Claim 1, reproduced below, is representative of the subject matter on appeal.

1. A system for providing negotiation advice to a customer service representative to negotiate with an individual delinquent on a debt obligation, the negotiation advice regarding alternative payment options specifically tailored to the individual's economic situation, said system comprising:

an interactive user application running on a computer, said computer having a display operatively connected to said computer;

a first graphical user interface (GUI) displayed on said display of said computer, said first GUI comprising one or more descriptive icons, said descriptive icons representing one or more financial situations;

a second GUI displayed on said display of said computer based on selection of one of said descriptive icons, said second GUI comprising one or more questions related to strategies for addressing the financial situation

represented by the selected one of said descriptive icons;
and

a processor, said processor operative to generate negotiation advice in response to selection of answers to said one or more questions that most closely correspond to a particular financial situation, said advice related to alternative payment options most suitable to said particular financial situation and displayed on said display.

THE REJECTION

The Examiner relies upon the following as evidence of unpatentability:

Bachman	US 6,315,196 B1	Nov. 13, 2001
Lee A. Spirer, <i>When 'bad' credit behavior becomes the norm</i> , 85 Credit World 18, Issue 6 (Jul/Aug 1997).		

Appellants seek our review of the Examiner's rejection of claims 1-15 under 35 U.S.C. § 103(a) (2002) as unpatentable over Bachman in view of Spirer.

ISSUE

Appellants contend that neither Spirer nor Bachman discloses a system for providing a customer service representative with negotiation advice (Appeal Br. 16, 19, 21, 22). Appellants further contend that the combination of Bachman and Spirer fails to teach a system for selecting among different alternative payment options most suitable to a particular financial situation (Appeal Br. 14, 19, 21, 22). Appellants further contend that there is no suggestion in the art that anyone of

ordinary skill would have any desire to use a first or second GUI, as claimed, with the combined teachings of Bachman and Spirer (Appeal Br. 15).

The issue before us is whether Appellants have shown that the Examiner erred in holding that the combination of Bachman and Spirer would have rendered the subject matter of claims 1-15 obvious to one having ordinary skill in the art at the time the invention was made.

FINDINGS OF FACT

The relevant facts include the following:

Spirer discloses that changes in the profile of delinquent customers have caused creditors to turn to, for example, behavioral scientists to devise “differentiated approaches” to debt collection for specific customer segments in an attempt “to address the root cause of nonpayment and then tailor solutions accordingly” (Spirer, Abstract). Spirer further discloses that for a cardholder with a history of delinquencies on multiple cards, creditors should skip a friendly reminder, and instead, “negotiate for a quick lump sum settlement of less than the outstanding balance, or offer a matching gift program” (Spirer 2). As such, Spirer recognizes the need to collect information about a debtor and use this information to determine which type of collection approach to use with the debtor. Spirer further discloses a table that includes various scenarios (categories of customers) and corresponding debt collection responses (negotiation advice) (Spirer 3). Spirer does not disclose a computer system to match the scenarios and responses. Spirer also does not disclose a system that includes first and second GUIs, as claimed, or

a processor operative to generate negotiation advice in response to selection of answers to one or more questions, as claimed.

Bachman discloses “a system for automatically implementing and tracking a credit protection program” (Bachman, col. 1, ll. 14-15). A credit protection program, such as credit insurance, “protect[s] the credit rating of credit card holders who are unable to make timely payments on their credit card accounts because of unforeseen circumstances, such as disability, involuntary unemployment, family leave, and death” (Bachman, col. 1, ll. 17-25). Bachman’s automated credit protector system processes “enrollment applications, notifies the administrator of enrollments in the credit protector program, and processes implementation of the deferment benefits of the program” (Bachman, col. 6, ll. 43-47). Enrollment in the program may be by telephone to a financial institution’s customer representative or to an administrator’s customer representative. “In either case, an enrollment file is created and transmitted to the credit protector system” (Bachman, col. 9, ll. 4-8). The cardmember, once enrolled, may then activate the benefit in the event of a qualifying occurrence (e.g., hospitalization). The cardmember may notify the financial institution within a certain time frame of the occurrence by telephoning the financial institution’s or administrator’s customer service representative (Bachman, col. 10, ll. 52-65). The customer service representative then attempts to verify the occurrence by telephone, if possible (Bachman, col. 10, l. 65 – col. 11, l. 1). Bachman discloses that “reason codes are used in tracking the status of the deferment of benefits of the

cardmember's credit protection" (Bachman, col. 12, ll. 53-55, Fig. 11). Bachman further discloses:

Accounts that are in the financial institution's collections queue after deferment are worked by collections customer service representatives of the financial institution and are evaluated. Dispute issues are handled manually, and fees may be charged back (Bachman, col. 13, l. 66 – col. 14, l. 3).

Bachman does not disclose a system including first and second GUIs, as claimed, or a processor for providing negotiation advice to a customer service representative in response to selection of answer to one or more questions that most closely correspond to a particular financial situation. Bachman also does not disclose displaying on a display or otherwise providing negotiation advice related to alternative payment options most suitable to the financial situation.

PRINCIPLES OF LAW

"Section 103 forbids issuance of a patent when 'the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains.'" *KSR Int'l Co. v. Teleflex Inc.*, 127 S.Ct. 1727, 1734, 82 USPQ2d 1385, 1391 (2007). The question of obviousness is resolved on the basis of underlying factual determinations including (1) the scope and content of the prior art, (2) any differences between the claimed subject matter and the prior art, (3) the level of skill in the art, and (4) where in evidence, so-called secondary considerations.

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Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). *See also KSR*, 127 S.Ct. at 1734, 82 USPQ2d at 1391 (“While the sequence of these questions might be reordered in any particular case, the [*Graham*] factors continue to define the inquiry that controls.”)

A factfinder should be aware, of course, of the distortion caused by hindsight bias and must be cautious of arguments reliant upon ex post reasoning.” *See Graham*, 383 U.S., at 36, 86 S. Ct. 684 [148 USPQ at 474] (warning against a “temptation to read into the prior art the teachings of the invention in issue” and instructing courts to “guard against slipping into the use of hindsight.”)

KSR, 127 S. Ct. at 1742, 82 USPQ2d at 1397 (citation omitted) (internal quotation omitted).

ANALYSIS

Neither Spirer nor Bachman discloses a system including first and second GUIs, as claimed, or a processor for providing negotiation advice to a customer service representative in response to selection of answers to one or more questions that most closely correspond to a particular financial situation. Further, the Examiner has failed to provide a clear articulation of how one having ordinary skill in the art at the time of the invention, and in possession of the teachings of Spirer and Bachman, would have been led to the claimed invention.

In particular, independent claims 1, 8, and 11 all contain similar recitations, requiring a first graphical user interface (GUI) that allows a user to select a descriptive icon representing an individual’s economic situation, a second GUI that

displays questions to the user based on the individual's economic situation, and the provision of negotiation advice related to alternative payment options most suitable to the individual's economic situation. Claims 1 and 8 further require that the negotiation advice specifically be related to selected answers to the questions from the second GUI.

The Examiner found that Bachman discloses "a system for providing negotiation advice to a customer service representative to negotiate with an individual delinquent on a debt obligation, the negotiation advice regarding alternative payment options specifically tailored to the individual's economic situation" (Answer 4). We disagree with this reading of Bachman.

Bachman's credit protection enrollment and implementation system does not disclose any situations in which a customer service representative negotiates with a caller. All that Bachman describes is the enrollment and activation processes, in which the customer service representative merely collects information from callers. Naturally, in collecting information, a customer service representative will be required to ask the caller questions. However, Bachman does not describe that these questions are presented to the customer service representative in a GUI or that there is a separate GUI that allows the representative to select a descriptive icon representing the caller's financial situation. Bachman further fails to disclose any situation in which the representative receives negotiation advice from the system.

The Examiner further found that "Bachman discloses that a customer service representative will confirm the condition of a debtor before a payment of the

debtor's monthly debts are paid by asking questions" (Answer 6). Based on this finding, the Examiner held that "it would have been obvious to one of ordinary skill in the art to combine the teachings of Bachman and Spirer in order to determine the type of problems related to the client becoming delinquent and thereby selecting the best type of program for the particular client" (Answer 6). We disagree with this conclusion. The passage in Bachman referred to by the Examiner is discussing the situation in which an enrollee wishes to activate the credit protection program due to a triggering event, such as hospitalization. All that Bachman discloses is that the customer service representative will confirm that the caller was actually hospitalized. This could be, for example, by the customer service representative getting the debtor's permission to contact the hospital to verify the caller's condition. Naturally, in this case, the customer service representative would need to ask the caller questions about the details of the hospitalization for subsequent confirmation. But, this disclosure, without more, would not have led one having ordinary skill in the art to the system and methods of claims 1, 8, and 11.

Although Spirer appears to disclose the use of alternative negotiation strategies based on a particular individual's economic situation, Spirer clearly fails to disclose any computer-based system for implementing this negotiation strategy, such as an interface for use with a customer service representative or collections agent. As stated *supra*, Bachman fails to disclose first and second GUIs, as claimed, for obtaining information from a debtor, or a processor that uses the

answers to certain questions to provide negotiation advice related to a debtor's financial condition.

As such, when Bachman and Spirer are combined, one skilled in the art might have been led to make a call center in which collections agents could collect information from the debtor and use this information to apply the negotiation advice of Spirer. This, however, falls short of the system and method of the claims. We fail to see how one having ordinary skill in the art would have been led to the specific first and second GUIs, as claimed, based on Bachman and Spirer, in the absence of hindsight.

The Examiner asserts that “[t]he use of descriptive icons on a graphical user interface having a panel containing questions and answers is old and well used in the graphical art [citing Tallman (US 5,764,923) and Boguraev (US 6,212,494)]... [and concluded that] [i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate a first and second graphical user interface containing descriptive icons in the combination of Bachman and Spirer in for estetical [sic, aesthetical] purposes and at the same time providing users with instant views of contents of a graphical screen or page.” (Answer 7). However, the conventionality of using descriptive icons on a graphical user interface having a panel containing questions and answers does not form a part of the statement of the rejection and appears to have been added in response to Appellants’ argument, further buttressing our view that only through hindsight would one having ordinary skill in the art have been led to the specific first and second GUIs, as claimed, based on Bachman and Spirer. Because our function is to review the adverse

decision of the Examiner, we are not inclined to take the role of an Examiner and craft a rejection that addresses the claimed interfaces.

In that regard, notwithstanding that we reverse the Examiner's rejection, we remand this application to the Examiner to consider whether one having ordinary skill in the art and wishing to create a computerized interface for a user, such as a customer service representative, to implement the general concepts of Spirer would have been led, based on teachings in the art of computer software interface design, to have designed the system and methods of the claims. For example, with regard to claim 1, we remand the application to the Examiner to consider whether one having ordinary skill in the computer software art would have been led to implement the general concepts of Spirer in an interface including a first GUI having descriptive icons representing financial situations and a second GUI that displays questions, based on the user's selection of a descriptive icon, that relate to strategies for addressing the selected financial situation.

CONCLUSIONS OF LAW

We conclude the Examiner failed to set forth a prima facie case of obviousness in the rejection of claims 1-15 under 35 U.S.C. § 103(a) as unpatentable over Bachman in view of Spirer.

DECISION

The decision of the Examiner to reject claims 1-15 is reversed and the application is remanded to the Examiner for further consideration of the patentability of the claims.

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No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a). *See* 37 C.F.R. § 1.136(a)(1)(iv) (2006).

REVERSED and REMANDED

jrg

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